



THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENTS *#40*

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OFFICE OF PETITIONS

In Re Application of:

Shelton, R. H.

Serial No.: 09/025,279

Filed: February 18, 1998

For: **STANDING ORDER DATABASE SEARCH
SYSTEM AND METHOD FOR INTERNET
APPLICATION**

Confirmation No.:

Group Art Unit: 2162

Examiner: Jean B. Fleurantin

Docket No. 050128-1010

PETITION UNDER 37 C.F.R. § 1.183

**Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

Sir:

Applicant hereby files this petition under 37 C.F.R. § 1.183 in connection with the petition decisions from the U.S. Patent and Trademark Office ("USPTO") mailed May 31, 2000 dismissing Applicant's "Petition under 37 C.F.R. 1.182" filed June 16, 1998 for non-provisional application Serial No. 09/025,279 and Applicant's "Request for Corrected Original Application Filing Receipt" filed April 4, 1997 for provisional application Serial No. 60/037,869. Based on the extraordinary situation described below, Applicant believes justice requires consideration of a response by Applicant to the averse petition decisions.

Applicant respectfully requests that the Commissioner waive the timeliness requirement under MPEP § 1002. Because of the tragic circumstances surrounding Applicant's prosecuting attorney, which are described in detail below, Applicant was not informed about the USPTO decisions until June 2005. Applicant has acted to correct the deficiencies noted in the USPTO decisions and provide a timely response with this petition.

In this petition, Applicant respectfully requests that the Commissioner correct the filing date of the provisional application under 37 C.F.R. § 1.10(d). Upon notice of the USPTO decision, Applicant has provided a timely response by presenting additional supporting evidence

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to overcome the decision. Moreover, as described in detail below, the delay in the USPTO decision has foreclosed the opportunity for the Applicant to obtain supporting evidence from the USPS corroborating the requested filing date.

Furthermore, Applicant respectfully requests that the Commissioner correct the filing date of the non-provisional application under 37 C.F.R. § 1.10(d). Upon notice of the USPTO decision, Applicant has provided a timely response by presenting additional supporting evidence to overcome the decision. In addition, as noted above and described in detail below, the delay in the USPTO decision has foreclosed the opportunity for the Applicant to obtain supporting evidence from the USPS corroborating the Express Mail pick up time.

This petition contains a summary of events providing a general overview, a statement of the facts involved, a statement of the actions requested, and the petition fee set forth in 37 C.F.R. § 1.17(f). Consideration of these facts and the requested actions are respectfully requested.

Summary of Events

On February 17, 1997, John L. Sigalos, Esq. on behalf of inventor Robert H. Shelton, filed a provisional application by Express Mail. Upon receipt, the USPTO assigned Serial No. 60/037,869 and an erroneous earlier filing date of February 10, 1997. Once the filing receipt was received, Mr. Sigalos petitioned to correct the filing date to February 17, 1997. In response, the USPTO sent a "corrected" filing receipt indicating another erroneous filing date of February 17, 1996 (day was correct, but year was wrong).

On February 17, 1998, Mr. Sigalos filed a non-provisional application by Express Mail claiming priority to the provisional application Serial No. 60/037,869. Upon receipt the USPTO assigned Serial No. 09/025,279 and an erroneous filing date of February 18, 1998. Once the filing receipt was received, Mr. Sigalos contacted the U.S. Postal Service which confirmed that, even though the Express Mail package entered the mail stream on February 17th, it was not processed at the Airport Mail Center until 1:56 a.m. on February 18th. In addition, it was discovered that the "corrected" provisional filing date listing a year of 1996 was in error. In response to these errors, Mr. Sigalos filed a petition to correct both the provisional and non-provisional filing dates on June 10, 1998.

On May 31, 2000, the USPTO mailed decisions to both petitions dismissing the corrections to both the provisional and non-provisional filing dates. Because of the intensive

strain from dealing with his daughter's estate following her tragic death from cancer in April 2000 and subsequent fight with his son-in-law for visitation rights with his granddaughter, Mr. Sigalos placed the decisions in his application files without responding to the USPTO or informing the inventor or assisting attorney of the dismissals. The petition decisions were discovered only recently during review of the application file by applicant and his attorneys after receiving the notice of allowance for the non-provisional application in June 2005.

Statement of Facts

1. John L. Sigalos, Esq. was engaged by inventor Robert H. Shelton of Allcare Health Management System ("Allcare") to prosecute a provisional application for patent entitled "Standing Order Database Search System and Method for Intranet and Internet Application."
2. In anticipation of submission of the provisional application, a "Verified Statement Claiming Small Entity Status" was prepared for Robert H. Shelton by John L. Sigalos, Esq. and sent by Express Mail (Declaration of John. L. Sigalos, paragraph 4).
3. On February 12, 1997, Mr. Shelton signed the "Verified Statement Claiming Small Entity Status" (Exhibit A-1) and returned the original to Mr. Sigalos by Federal Express from Irvine, California (Declaration of Robert H. Shelton, paragraph 4). The Federal Express shipment on 02/12 from zip code 92612 (Irvine, CA) was confirmed on Mr. Shelton's American Express receipt under Reference No. 501049-0 (Exhibit A-2).
4. On February 12, 1997, Mr. Sigalos sent a letter to Andrew M. Hassell, Esq., a patent attorney assisting Mr. Sigalos with prosecution of electrical applications, requesting that he return his comments about the proposed application on February 14 (Exhibit B-1, provisional patent omitted). The letter and proposed application were sent via UPS Next Day Air (Exhibit B-2). Mr. Hassell responded to Mr. Sigalos prior to the filing of the provisional application (Declaration of Andrew M. Hassell, paragraph 4).
5. On February 12, 1997, Mr. Shelton sent an e-mail to John P. Fanning, staff coordinator of the NCVHS Subcommittee on Privacy and Confidentiality, regarding privacy standards of individually identifiable health information (Exhibit C). In the e-mail, Mr. Shelton stated that they were "*currently preparing additional patent applications* concerning this novel

system and method for assuring the privacy of patient records . . .” and asked “if there is a way that our commercial interests can be protected and the public good achieved by temporarily holding the content of any writings we submit 'confidential between us and the Subcommittee' for several months' time ***until we complete the preparation and filing of the appropriate patent applications.***” (Emphasis added). Mr. Shelton confirmed the provisional application had not been filed at the time this e-mail was sent (Declaration of Robert H. Shelton, paragraph 5).

6. On February 14, 1997, Mr. Shelton sent an e-mail to Mr. Sigalos confirming his sole inventorship prior to the filing of provisional application (Exhibit D). This e-mail was sent prior to the filing of the provisional application (Declaration of Robert H. Shelton, paragraph 6).
7. On February 17, 1997, Mr. Sigalos filed the provisional application including cover sheet, certificate of Express Mail deposit, signed “Verified Statement Claiming Small Entity Status,” acknowledgement of receipt, and filing fee payment (Exhibit E-1, provisional patent omitted) on behalf of Mr. Shelton. In addition, Mr. Sigalos sent a letter to Mr. Shelton confirming submission on February 17 (Exhibit E-2, enclosure omitted) via Federal Express (Declaration of John. L. Sigalos, paragraph 8). The Federal Express shipment on 02/17 from zip code 75230 (Dallas, TX) was confirmed on Mr. Shelton’s American Express receipt under Reference No. 501058-0. Billing of shipping charges directly to Mr. Shelton’s Federal Express account was confirmed by Mr. Shelton (Declaration of Robert H. Shelton, paragraph 7) and Mr. Sigalos (Declaration of John. L. Sigalos, paragraph 8).
8. The provisional application was assigned Serial No. 60/037,869 and the acknowledgement of receipt was returned to Mr. Sigalos stamped with an erroneous USPTO mailroom receipt date of February 10, 1997 (Exhibit F-1). The provisional application filing receipt (PTO-103P) that was sent to Mr. Sigalos indicated a filing date of 02/10/97 (Exhibit F-2).
9. On March 1, 1997, Mr. Sigalos submitted a billing statement to Allcare for services rendered during the month of February (Exhibit G). Charges for the Express Mail of the

“Verified Statement Claiming Small Entity Status” to Mr. Shelton and the Courier Mail (UPS) of the proposed application to Mr. Hassell are confirmed on the billing statement.

10. On March 31, 1997, Mr. Sigalos submitted a “Request for Corrected Original Application Filing Receipt” to the USPTO petitioning that the provisional application filing date be corrected from February 10, 1997 to February 17, 1997 (Exhibit H-1). The acknowledgement of receipt was returned to Mr. Sigalos stamped with a USPTO Mailroom receipt date of April 4, 1997 (Exhibit H-2).
11. On March 31, 1997, Mr. Sigalos sent a letter to Allcare (Exhibit J) with the provisional application filing receipt noting an incorrect filing date of February 10, 1997 and confirming the submittal of the request to correct. In the letter, Mr. Sigalos further confirmed a non-provisional filing deadline of February 17, 1998.
12. The USPTO sent a “corrected” provisional application filing receipt (PTO-103P) to Mr. Sigalos indicating filing “corrected” date of February 17, 1996 (Exhibit K-1). On October 21, 1997, Mr. Sigalos sent Allcare notification of the corrected filing date and reaffirmed a non-provisional filing deadline of February 17, 1998 (Exhibit K-2). The erroneous year (1996) was subsequently noted upon receiving the filing receipt for the non-provisional application in February 1998 (Declaration of Robert H. Shelton, paragraph 14 and Declaration of John L. Sigalos, paragraph 17).
13. On February 17, 1998, the non-provisional application “Standing Order Database Search System and Method for Intranet and Internet Application,” including cover letter, certificate of Express Mail deposit, unsigned “Declaration and Power of Attorney for Patent Application,” and acknowledgement of receipt, was filed via Express Mail (Exhibit M, non-provisional patent omitted). The non-provisional application claimed priority to provisional application Serial No. 60/037,869 based on a filing date of February 17, 1997. The cover letter confirmed that the “Verified Statement Claiming Small Entity Status” was submitted with provisional application Serial No. 60/037,869. The application package was deposited in the Express Mail collection box prior to the final pickup time on February 17, 1998 (Declaration of John L. Sigalos, paragraph 15).

14. The filing package was deposited in the Express Mail collection box, located on the property of Carillon Towers, 13601 Preston Road, Dallas, Texas 75240, prior to the final pickup time of 5 p.m. (Declaration of John L. Sigalos, paragraph 15). Mr. Leslie C. Cook, Esq., with an office at Carillon Towers, has confirmed a final pickup time of 5 p.m. (Declaration of Leslie C. Cook, paragraph 4). The Express Mail collection box was subsequently removed from that location (Declaration of Leslie C. Cook, paragraph 3) and the U.S. Postal Service ("USPS") confirmed that collection records for 1998 were not retained (Exhibit N).
15. In a letter dated March 19, 1998, the USPS confirmed that, although the package was deposited on February 17th, it was not processed at the Airport Mail Center until February 18th (Exhibit P-1). The Express Mail receipt indicates a "Time in:" of 01:56 a.m. on February 18, 1998 (Exhibit P-2).
16. The non-provisional application was assigned Serial No. 09/025,279 and the acknowledgement of receipt was returned to Mr. Sigalos stamped with USPTO Mailroom receipt date of February 18, 1998 (Exhibit Q-1). The filing receipt (PTO-103X) sent to Mr. Sigalos confirmed a non-provisional application Serial No. 09/025,279 with a filing date of 02/18/98. In addition, the filing receipt confirmed that the non-provisional application contained data as claimed by Applicant under provisional application No. 60/037,869 02/17/96 (Exhibit Q-2).
17. On June 10, 1998, Mr. Sigalos filed a "Petition under 37 C.F.R. 1.182" to correct the filing dates of both the non-provisional application Serial No. 09/025,279 from February 18, 1997 to February 17, 1998 and the provisional application Serial No. 60/037,869 from February 17, 1996 to February 17, 1997 (Exhibit R-1). The USPTO acknowledgement of receipt was dated June 16, 1998 (Exhibit R-2).
18. On October 7, 1999, Mr. Sigalos requested the status of the Petition under 37 C.F.R. 1.182 (Exhibit S-1). The USPTO Acknowledgement of Receipt was dated October 12, 1999 (Exhibit S-2).
19. On April 14, 2000, the daughter of Mr. Sigalos died from cancer initially diagnosed in 1997 (Exhibit T-1). Subsequently, Mr. Sigalos became Executor of his daughter's estate

- (Exhibit T-2) and involved in a petition for visitation rights with his granddaughter (Exhibit T-3). The mental and physical strain produced by this situation affected Mr. Sigalos' ability to focus effectively on his work during the year 2000 as is evidenced by his deposition testimony provided for *Highmark, Inc. v. Allcare Health Management* on July 27, 2004 (Exhibit T-4, pages 10, 94, and 116-117).
20. Upon the suggestion of Mr. Shelton, Mr. Hassell took the lead for prosecution and appeal of the non-provisional application Serial No. 09/025,279 from Mr. Sigalos (Declaration of Robert H. Shelton, paragraph 18 and Declaration of Andrew M. Hassell, paragraph 7). Mr. Sigalos retained control of petitions to correct the filing dates (Declaration of John L. Sigalos, paragraph 21 and Declaration of Andrew M. Hassell, paragraph 8).
 21. On May 31, 2000, the USPTO mailed to Mr. Sigalos a decision to the petition filed April 4, 1997 requesting a correction of the filing date from February 10, 1997 to February 17, 1997 for provisional application Serial No. 60/037,869 (Exhibit U). The petition was dismissed for failure to provide evidence of the filing date and resulted in vacating the "corrected" filing receipt, which gave a filing date of February 17, 1996.
 22. On May 31, 2000, the USPTO mailed to Mr. Sigalos a decision to the petition filed June 16, 1998 requesting a correction of the filing date from February 18, 1998 to February 17, 1998 for non-provisional patent application Serial No. 09/025,279 (Exhibit V). The petition was dismissed for failure to provide evidence of last scheduled pick up time from Express Mail collection box.
 23. Because of emotional strain brought on by his daughter's death, Mr. Sigalos placed the petition dismissals in his files but failed to enter due dates for a response in either his docket book (Exhibit W-1) or the file wrapper cover log (Exhibit W-2). Mr. Shelton and Mr. Hassell were not notified of receipt of the USPTO decisions (Declaration of John L. Sigalos, paragraph 23).
 24. On June 1, 2005, a Notice of Allowance and Fee(s) Due (PTOL-85) for the non-provisional application was mailed to Mr. Hassell (Exhibit X).
 25. In June 2005, the application file was reviewed prior to the issuance of the allowed patent. At that time, Mr. Sigalos discovered the USPTO decisions dismissing the

petitions to correct the filing dates of the provisional and non-provisional applications (Declaration of John L. Sigalos, paragraph 24). Shortly thereafter, Mr. Shelton and Mr. Hassell first became aware of the USPTO decisions (Declaration of Robert H. Shelton, paragraph 20 and Declaration of Andrew M. Hassell, paragraph 9).

Statement of the Actions Requested

1. Applicant petitions the Commissioner to waive the timely response requirement of MPEP § 1002 in connection with the petition decisions from the USPTO mailed May 31, 2000 dismissing Applicant's "Petition under 37 C.F.R. 1.182" filed June 16, 1998 for non-provisional application Serial No. 09/025,279 (Paper No. 14) and Applicant's "Request for Corrected Original Application Filing Receipt" filed April 4, 1997 for provisional application Serial No. 60/037,869 (Paper No. 3) and allow consideration of the applicant's present response to the decisions for at least the following reason:
 - Because of the tragic circumstances surrounding the originating attorney, Mr. Sigalos, during the year 2000, Applicant was not informed about the USPTO decisions dismissing the petitions to correct filing dates for both the provisional and non-provisional applications until June 2005. Upon being informed of the situation, Applicant acted to correct the deficiencies noted in the USPTO decisions and provided a timely response with this petition. It is requested that the timely response requirement of MPEP § 1002 be waived and the present requests for correction of the filing dates of the provisional and non-provisional applications be considered based on the evidence provided herein.
2. Applicant petitions the Commissioner that provisional application Serial No. 60/037,869 be accorded the filing date of February 17, 1997 on which the papers were sent "Express Mail Post Office to Addressee" under mailing label No. EM064934589US for at least the following reasons:
 - Applicant timely requested an initial correction to the filing date of the provisional application. The USPTO decision dismissed the petition under 37 C.F.R. § 1.10(c) for failing to provide "a true copy of the 'Express Mail' mailing label showing the 'date-in' and of any other official notification by the USPS relied upon to show the

date of deposit.” Upon discovering the USPTO decision dismissing the request, Applicant provided a timely response by presenting evidence to overcome the noted deficiency of the previous petition submitted in 1997.

The USPS was contacted for collection information when a copy of the mailing label was not located by Mr. Sigalos. As noted by Exhibit N, the USPS has confirmed that Express Mail collection information for the 75240 postal area is no longer available for 1998 or earlier. Therefore, Applicant submits for consideration the following additional supporting evidence corroborating a filing date of February 17, 1997.

The “Verified Statement Claiming Small Entity Status” was signed and returned to Mr. Sigalos for submission with the provisional application on February 12, 1997. Also, the proposed application was sent to Mr. Hassell on February 12, 1997 for review and comments before filing the provisional application. In addition, e-mail correspondence by Mr. Shelton confirmed that the application had not been prior to February 14, 1997. Furthermore, all provisional application forms were signed and dated for February 17, 1997 including the confirmation letter to Mr. Shelton.

Based on the supporting evidence submitted with this petition, it is respectfully requested that the filing date of February 17, 1997 be accorded to provisional application Serial No. 60/037,869.

- Applicant timely requested an initial correction to the filing date of the provisional application. By correcting the filing date to February 17th on the provisional application filing receipt, the USPTO indicated acceptance of the Applicant’s petition. As a result, the Applicant reasonably relied upon this information to determine that no further action was required to obtain the correct filing date for the provisional application.

The Applicant’s reliance on the USPTO correction, was evidenced by the repeated correspondence confirming a February 17, 1998 filing date. The USPTO delay in supplying a decision until May 2000 foreclosed any opportunity for the Applicant to take additional corrective action, such as either filing the non-provisional

application by the filing date of February 10, 1998 or responding to the decision by supplying supporting evidence from the USPS of the requested date. As indicated by the e-mail sent on January 9th, Applicant was sufficiently aware of the need to file a non-provisional application within one-year of filing the provisional application. Moreover, as confirmed by the USPS, Express Mail collection information prior to 1998 is no longer available.

Based on the evidence discussed above, it is respectfully requested that the “corrected” filing receipt be considered USPTO acceptance of the Applicant’s original petition and a filing date of February 17, 1997 be allowed for provisional application Serial No. 60/037,869.

3. Applicant petitions the Commissioner that non-provisional application Serial No. 09/025,279 be accorded the filing date of February 17, 1998 on which the papers were sent “Express Mail Post Office to Addressee” under mailing label No. EI229088857US for at least the following reason:
 - Applicant timely requested an initial correction to the filing date of the non-provisional application. The USPTO decision dismissed the petition under 37 C.F.R. § 1.10(d) for failing to provide corroboration of the last scheduled pick up time. Upon discovering the USPTO dismissal to the request, Applicant provided a timely response by presenting evidence to overcome the noted deficiency of the previous petition submitted in 1998.

As indicated in the March 19, 1998 letter from the USPS, it was acknowledged that the Express Mail package was deposited in the collection box on February 17, 1998. In order to provide supporting evidence as required by the USPTO decision, the USPS was contacted for additional collection information. Based upon this request, the USPS confirmed that Express Mail collection information for the 75240 postal area is no longer available for 1998. Therefore, Applicant submits for consideration the following additional supporting evidence corroborating the final pick up time.

Mr. Sigalos confirmed deposit of the Express Mail package prior to the final pick up time of 5:00 p.m. in his present Declaration, as well as his original

Declaration submitted with the 1998 "Petition under 37 C.F.R. 1.182." In addition, the Declaration of Leslie C. Cook confirms a final collection time of 5:00 p.m. during February 1998. Moreover, it would be necessary for the Express Mail package to have been collected and enter the mail stream on February 17th in order for it to be taken to central processing at the Airport Mail Center by 1:56 a.m. on February 18th.

Based on the supporting evidence submitted with this petition, it is respectfully requested that the filing date of February 17, 1998 be accorded to non-provisional application Serial No. 09/025,279.

4. Applicant petitions the Commissioner that the non-provisional application Serial No. 09/025,279 be accorded priority to the provisional application Serial No. 60/037,869 based on acceptance of the above mentioned filing dates.

Petition Fee

Authorization is hereby made to charge the amount of \$400.00 as set forth in 37 C.F.R. § 1.17(f) to our Deposit Account No. 20-0778.

Respectfully submitted,



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Date: July 29, 2005
Telephone: (770) 933-9500

Docket: 50128-1010

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